

REMARKS

In the final office action dated November 19, 2003, the examiner has finally rejected claims 1-7, 10 and 11-13 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,576,374 to Betso et al. The sole purpose of this reply to final is to amplify and clarify the remarks Applicants made in their prior response concerning the effective date of the Betso et al. reference.

On page 4 of the final office action, the examiner makes the following statement:

The examiner has reviewed the applicants' arguments. While the applicants have listed a number of facts based on the prosecution history of the patent, the examiner feels that the prosecution history of the patent is not relevant to the prosecution of this application. All US patents have a presumption of validity.

It is indisputably true that all issued U.S. patents have a presumption of validity. However, the validity or invalidity of the Betso claims are totally irrelevant to the effectiveness of Betso as a reference and to the examination of the instant application. What is relevant, however, is when various portions of the Betso patent became effective as a reference against Applicants' claims.

The only disclosure of any kind of roofing product or application in the Betso et al. patent appears in claim 15. The term "single ply roofing" appears in a Markush-type claim in a "group consisting of automotive hoses, single ply roofing, and wire and cable voltage insulation." Neither the term "roofing" nor the more specific term "single ply roofing" appears anywhere in Betso's specification. The examiner may verify this for himself, if he wishes. The specification does, of course, teach extrusion molding (column 9, lines 49 plus), but none of the items listed in this paragraph of the specification include roofing or anything remotely similar to roofing. The actual items Betso discloses in his specification which can be produced by the listed molding

operations are “automotive bumpers, fascia, wheel covers and grilles, as well as other household and personal articles, including, for example, freezer containers.” (Column 9, lines 50-53)

Accordingly, we have a reference whose specification discloses raw materials which arguably correspond to Applicants’. The specification further discloses using extrusion molding to form certain enumerated articles made of the disclosed raw materials. Only in its claims does the Betso patent also teach fabricating single ply roofing from the disclosed materials.

Since the teaching of single ply roofing was not part of Betso’s patent application at a time period that predated the priority date of Applicants’ application, how could it possibly be considered a prior art teaching with reference to Applicants’ claims? As Applicants pointed out to the examiner, the single ply roofing language of claim 15 did not appear in the original Betso application, nor in any of its parent applications. Rather, it was added by amendment on March 27, 1995. Applicants remind the examiner that the priority date of their application is August 4, 1994, approximately nine months before the single ply roofing language first appeared in the claims of the Betso reference. Accordingly, this portion of Betso’s issued patent cannot be used as a prior art teaching with reference to Applicants’ claims.

That is the argument which Applicants attempted to make in the prior office action, but it appears that the examiner misunderstood this argument. Applicants are not arguing that Betso is ineffective as a reference because claim 15 is probably invalid. Rather, they are arguing that the single ply roofing language of claim 15 **post dates** their own application. For that sole and only reason, this portion of Betso’s patent cannot possibly be considered an anticipatory reference.

If necessary, Applicants will take this issue to the Board of Appeals. However, Applicants are hopeful that, with the preceding explanation and clarification, the examiner will

appreciate the truth and logic of Applicants' argument and the unsoundness of his own rejection, and withdraw it.

Applicants do wish to thank the examiner for withdrawing the §103 rejection and indicating that claims 8, 9 and 15-20 could be put in condition for allowance. However, Applicants are unwilling to settle for this narrow protection for the simple reason that there is no disclosure, teaching or reference in the Betso et al. patent which can possibly be considered anticipatory to their own claimed invention. Accordingly, all of the pending claims are patentable over the prior art, and Applicants respectfully request the examiner to allow them to issue.

Respectfully submitted,



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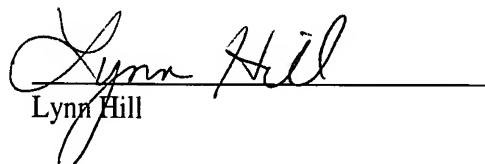
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DATE OF DEPOSIT January 20, 2004

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